

PATENT APP. NO. 10/601,568

ATTY. DOCKET NO. 53394.000733

AMENDMENT IN RESPONSE TO 1/26/05 OFFICE ACTION

### III. REMARKS

Claims 1-22 are pending in the application and have been rejected. Applicant hereby amends claims 1, 3, 10, and 14, and cancels claims 4, 13 and 20. New claims 23-25 have been added and are fully supported by page 12 of the specification. No new matter is presented by the amendments. Accordingly, Applicant respectfully requests entry thereof and reconsideration and allowance of claims 1-3, 5-12, 14-19 and 21-25, in light of the following remarks.

#### A. Claim Rejections Under 35 U.S.C. § 102(b)

On page 2 of the Action, claims 1-22 are rejected under 35 U.S.C. §102(b) as being anticipated by WO 99/64083 to Tramontana ("Tramontana"). Applicant respectfully traverses this rejection and requests reconsideration and allowance of the pending claims in view of the following remarks.

A claim is anticipated by a reference only if "each and every element as set forth in the claim is found, either express or inherently described" in the reference. *Verdegaal Bros v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Office Action alleges that Tramontana discloses an absorbent article containing adhesives "wherein the adhesive contains essential oils for beneficial effects to the skin," citing Tramontana at p.3, ll. 1-12, p. 7, ll. 6-21 and examples and claims. Action at p. 2. Based on these teachings, the Action alleges that the Tramontana anticipates the present claims. However, Applicant respectfully submits that Tramontana does not expressly or inherently disclose an absorbent article having an adhesive that comprises a skin wellness ingredient in the amount ranging from 0.0003 to 0.06 weight%, based on the total weight of the article.

As noted by the Examiner, Tramontana discloses the use of an essential oil, and that the oil may optionally be added to an adhesive used in the production of a sanitary napkin. The essential oil is used for the purpose of, and in an amount effective to "provide a pleasant aroma and inhibit microbial growth." Tramontana at

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pp. 2-3. While Tramontana discloses the use of from 0.1 to 8 weight percent essential oil, it fails to disclose the basis for this range. That is, it is not clear from Tramontana whether the essential oil is used in an amount of 0.1 to 8 weight percent, based on the weight of the absorbent article, or based on the weight of the element to which the adhesive is added. The examples fail to elucidate the basis, since the examples merely illustrate adding the essential oil directly to a selected bacterium-infected medium and measuring its effectiveness in inhibiting microbial growth. For purposes of argument only, Applicant assumes that the weight percentage ranges described in Tramontana are based on the weight of the absorbent article.

The effective amount disclosed in Tramontana is 0.1 to 8.0 weight %. In contrast, the present invention uses the skin wellness ingredients to provide a skin wellness benefit "while not causing skin irritation or other adverse side effects" caused by the effective ingredient. Specification at p. 1. In order to achieve the purpose of the present invention, the effective amount of the essential oil is *reduced* over that used in the prior art. Specification at pp. 14-15. Independent claims 1, 10, and 14 have been amended to recite that the adhesive comprises a skin wellness ingredient in the amount ranging from 0.0003 to 0.06 weight%, based on the total weight of the article. Support for this amendment may be found on pages 15-16 of the specification, which discusses possible uses for the claimed adhesive and the resultant levels of skin wellness ingredient in the absorbent garment.

Assuming that Tramontana intended weight% to be based on the total weight of the absorbent article, the Tramontana range does *not* read on the range recited in the present claims, and therefore Tramontana fails to anticipate the present claims. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this ground of rejection, and allowance of claims 1-3, 5-12, 14-19 and 21-22.

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B. Claim Rejections Under 35 U.S.C. § 103(a)

On pages 3-4 of the Action, claims 1-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tramontana. Applicant respectfully traverses this rejection and requests reconsideration and allowance of the pending claims in view of the following remarks.

The Action alleges that Tramontana discloses an absorbent article containing adhesives "wherein the adhesive contains essential oils for beneficial effects to the skin," citing page 3, lines 1-12, page 7, lines 6-21 and examples and claims. Action at p. 2. The Action alleges further that Tramontana "explicitly teaches rosemary oil as the preferred essential oil in effective amounts between about 0.1 and about 8 wt. percent, which meets applicant's claimed ranges." Action at p.4. Based on these teachings, the Action alleges that the Tramontana renders obvious the present claims.

Three criteria must be met to establish a *prima facie* case of obviousness: (1) there must be some suggestion or motivation to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all the claim limitations. See MPEP § 2142 *et seq.* Applicant respectfully submits that a *prima facie* case has not been established here because Tramontana does not teach or suggest an absorbent article having an adhesive that comprises a skin wellness ingredient in the amount ranging from 0.0003 to 0.06 weight%, based on the total weight of the article, as recited in the present claims. Moreover, a person having ordinary skill in the art would not have been motivated to reduce the effective amount of oil of Tramontana because it would frustrate the inventor's purpose of providing an aroma and inhibiting microbial growth.

Tramontana discloses that "In accordance with . . . the present invention, there has been provided a disposable absorbent article containing an essential oil in an amount effective to provide a pleasant aroma and inhibit microbial growth."

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Tramontana at p. 2, ll. 29-31. The purpose of Tramontana therefore is to provide a pleasant aroma and inhibit microbial growth. Tramontana discloses that the effective amount of essential oil used to provide a pleasant aroma and inhibit microbial growth is between 0.1 and 8.0 weight%. Tramontana at p. 5. In contrast, the present claims recite an adhesive having a skin wellness ingredient in the range of 0.0003% to 0.06% by weight. Tramontana fails to teach the claimed range.

Moreover, Tramontana contains no disclosure that would motivate a person skilled in the art to *reduce* the amount of essential oil disclosed therein to less than 0.06 weight%, based on the total weight of the absorbent article, because doing so would frustrate the inventor's purpose. Indeed, a person of ordinary skill in the art would anticipate that reduction of the amount of essential oil to 0.06% by weight, because the skilled artisan would expect that such a small amount (*e.g.*, on the order of about .025 ml, or about 7.5 times less than that used in the examples) would have the adverse effect of increasing the odor, (*i.e.*, reduce the pleasant aroma) and would reduce the anti-microbial effect of the absorbent article, thereby frustrating the purpose of Tramontana. Furthermore, Tramontana does not disclose or suggest the possibility of skin irritation or other adverse side effects caused by an effective ingredient. Thus, Tramontana does not appreciate the fact that higher amounts of oils (*i.e.*, outside the claimed range) could result in skin irritation or adverse side effects.

In contrast to Tramontana, the present invention incorporates skin wellness ingredients, *e.g.*, essential oils, in an adhesive formulation to provide a skin care benefit "*while not causing skin irritation or other adverse side effects otherwise experienced by the use of other ingredients added to absorbent garments during their manufacture.*" Specification at p. 1 (emphasis added). Thus, the intended purpose of the present invention, as expressly stated in the specification, is different from the intended purpose disclosed in Tramontana. Tramontana discloses that the effective amount of essential oil used to provide a pleasant aroma and inhibit microbial

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growth is between 0.1 and 8.0 weight%. Tramontana at p. 5. Applicant notes that this range is *included* in the range at which Applicant anticipates negative skin effects, especially if applied across the entire topsheet — one of the preferred modes of application disclosed in Tramontana. *See id* at p. 7, ll. 22-31. It is therefore not surprising that the amounts of the skin wellness ingredients of the present invention are *far less* than the amounts of anti-microbial or anti-odor ingredients of Tramontana.

In order to achieve the purpose of the present invention, the effective amount of the skin wellness ingredient is reduced when compared to amounts used in the prior art, *e.g.*, Tramontana. Applicant observes on pages 14-15 of the specification that

While it has previously been known to include certain additives in absorbent garments, these additives typically are present in relatively high weight percentages to achieve their desired effects. Typically, additives were included in amounts from around 0.006 weight% to about 1.5 weight%, based on the weight of the top sheet. The inventor has found that including certain additives at these amounts may cause negative skin effects, such as skin irritation, and the like.

This supports the assertion that there is an effective range for the level of skin wellness ingredient in a diaper that both provides skin wellness benefits and does not cause skin irritation for the user. Applicant suggests that the appropriate range is: 0.0003 weight% to 0.06 weight%, based on the total weight of the article to provide skin wellness benefits and not cause skin irritation. In addition, the claimed mode of application of including the essential oil in an adhesive that can be applied in discrete locations, rather than on the full width of a topsheet, also aids in the reduction of potential skin irritation.

The present claims recite an absorbent article having an adhesive that contains a skin wellness ingredient in an amount ranging from 0.0003 to 0.06 weight%, based on the total weight of the article. Tramontana does not teach or suggest an absorbent article having an adhesive that comprises a skin wellness ingredient in within the

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claimed range. Moreover, a person having ordinary skill in the art would not have been motivated to reduce the effective amount of oil of Tramontana because it would frustrate the inventor's purpose of providing an aroma and inhibiting microbial growth. Therefore, Tramontana does not render obvious the present claims and accordingly, Applicant respectfully requests reconsideration and withdrawal of this ground of rejection, and allowance of claims 1-3, 5-12, 14-19 and 21-22.

#### IV. CONCLUSION

In view of the foregoing, Applicant respectfully submits that pending claims 1-3, 5-12, 14-19, and 21-25 are allowable. An early notice to this effect is earnestly solicited. Should there be any questions concerning the foregoing, Examiner Sheikh is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

HUNTON & WILLIAMS LLP

Dated: 4/26/05

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